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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,654	07/02/2001	Kiminori Tamai	P10742400031	5763

23353 7590 01/22/2003

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EXAMINER

RIBAR, TRAVIS B

ART UNIT	PAPER NUMBER
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1711

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DATE MAILED: 01/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/868,654

Applicant(s)

TAMAI ET AL.

Examiner

Travis B Ribar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☒ Claim(s) 6 and 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. The examiner maintains all claim objections and rejections put forth in the office action dated August 26, 2002.

#### ***Claim Objections***

2. Claim 6 and 7 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Currently, the claims, though amended to be in independent form, only provide for a future intended use of a transparent plastic film. Any film that meets the structural limitations of the films in these claims will also inherently possess the ability to be used in the manner the applicant claims. The future intended uses of these films in these claims do not provide a material limitation to the claims upon which patentability could depend.

#### ***Claim Rejections - 35 USC § 102***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1-4 and 6-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Crouch et al.

The office action dated August 26, 2002 contains the text of this rejection.

5. Claims 1 and 4-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Tsuchiya et al.

The office action dated August 26, 2002 contains the text of this rejection.

6. Claims 1-2 and 6-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Hosokawa et al.

The office action dated August 26, 2002 contains the text of this rejection.

7. Claims 1 and 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki et al.

The office action dated August 26, 2002 contains the text of this rejection.

***Claim Rejections - 35 USC § 103***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Crouch et al. in view of both Suzuki et al. and Tsuchiya et al.

The office action dated August 26, 2002 contains the text of this rejection.

10. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. in view of Crouch et al.

The office action dated August 26, 2002 contains the text of this rejection.

11. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuchiya et al. in view of Crouch et al.

The office action dated August 26, 2002 contains the text of this rejection.

12. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hosokawa et al. in view of Crouch et al.

The office action dated August 26, 2002 contains the text of this rejection.

13. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hosokawa et al. in view of Tsuchiya et al.

The office action dated August 26, 2002 contains the text of this rejection.

14. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hosokawa et al. in view of Suzuki et al.

The office action dated August 26, 2002 contains the text of this rejection.

### ***Response to Arguments***

15. Applicant's arguments filed December 6, 2002 have been fully considered but they are not persuasive.

16. The applicant argues that Crouch and Tsuchiya et al. do not inherently contain the properties that the examiner asserts them to contain. This argument is based on the points that these references do not use a solvent to cast the hardcoat layer onto the plastic film and that the multilayer plastic films are not injection molded.

Regarding the solvent argument, the examiner notes that this aspect of the invention is not present in the claims and the applicant cannot depend solely on this to overcome the references. In addition, the part of the specification that the applicant points to (page 15) as support for the presence of solvent adding properties to the final product does not support such a claim. The passage only states that solvent may be used in the present invention and does not point to any added properties or advantages that this embodiment of the invention contains. Therefore the presence of solvent in the present invention in an intermediate step (the solvent is not present in the final product) is not deemed to add any properties that are not inherently present in the references.

The applicant also argues that the references do not include the injection molding aspect of the present invention. However, this aspect of the invention (along with the solvent part of the invention) constitutes a product-by-process characteristic of the present invention. In product-by-process claims, "once a product appearing to be substantially identical is found and a 35 U.S.C. 102 or 103 rejection made, the burden shifts to the applicant to show an unobvious difference." MPEP 2113. The applicant

has not shown that the method by which the product is made, specifically injection molding using a solvent, causes the product to be patentably distinct from the product produced by the reference(s). This rejection under 35 U.S.C. 102 is therefore proper because the "patentability of a product does not depend on its method of production." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

17. The applicant also argues that Hosokawa et al. is not applicable to the present invention because the required properties are not inherent to the product in Hosokawa et al. One argument the applicant puts forth is that the composition of the hardcoat layer in the reference is different than the composition of the hardcoat layer in the present application.

This argument is not persuasive because the applicant has not claimed any specific chemical structure and the specification does not support the position that only the disclosed experimental systems provide the claimed properties. The hardcoat layer in Hosokawa et al. comprises as a main component the material that the applicant specifies as relevant to the present invention and also states that the presence of the silica sol in the composition improves the properties of the hardcoat. Therefore, the examiner feels justified in expecting the hardcoat layer in Hosokawa et al. to inherently possess the properties that the applicant claims.

The applicant also argues that the hardcoat layer in Hosokawa et al. does not possess the same cracking characteristics at high temperatures as the applicant's invention. The applicant has not claimed these properties at a high temperature,

claiming only the characteristics at 22 °C, so the higher temperature properties on their own are not enough to overcome the inherency argument. Further, the record does not presently support the applicant's assertion that since the reference does not disclose the high temperature properties of the present invention it does not possess them. The record also does not support the applicant's position that if a material does not have certain properties at high temperatures it does not have other properties at lower temperatures.

The examiner therefore maintains his position that the applicant's claimed properties are inherent to the applied reference.

18. The applicant also argues the presence of the applicant's claimed inherent properties in Suzuki et al. because Suzuki et al. includes monomers that are not present in the applicant's list of materials that yield the present invention. However, the examiner notes that the chemical composition of the hardcoat layer is not present in the claims, so the chemical composition by itself may not overcome the application of this reference to the present application. Further, the examiner notes that the majority of the compound in Suzuki et al. is the compound that the applicant claims forms the present invention (column 10, line 37). Therefore, the examiner believes the composition to inherently contain the properties the applicant claims.

The applicant also argues that the references do not include the injection molding aspect of the present invention. However, this aspect of the invention constitutes a product-by-process characteristic of the present invention. In product-by-process



claims, "once a product appearing to be substantially identical is found and a 35 U.S.C. 102 or 103 rejection made, the burden shifts to the applicant to show an unobvious difference." MPEP 2113. The applicant has not shown that the method by which the product is made, specifically injection molding, causes the product to be patentably distinct from the product produced by the reference(s). This rejection under 35 U.S.C. 102 is therefore proper because the "patentability of a product does not depend on its method of production." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985).

### ***Conclusion***

19. The examiner notes that the invention appears to be a method of testing a coated substrate to check the properties of a similarly molded product. The method of testing that the applicant claims (the relationship in claim 1) is not present in the prior art that the examiner searched. If the claims were rewritten to reflect that the applicant were claiming a *method of testing* a coated substrate, the claims may be patentable pending a search of the prior art for the new claims.

20. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis B Ribar whose telephone number is (703) 305-3140. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Travis B Ribar  
Examiner  
Art Unit 1711

TBR  
January 16, 2003



James J. Seidleck  
Supervisory Patent Examiner  
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